

REMARKS

Summary of Telephonic Interview

In a telephonic interview between the undersigned and Examiner Scott Jarrett on February 1, 2010, the new § 101 rejection raised by the Board in the Decision on Appeal dated December 3, 2009, was discussed. It was agreed that adding “by the computer” to each of the steps of claim 42 should address the § 101 rejection of claim 42 and its dependent claim 33. No other claims were discussed. No references or exhibits were discussed.

Response to Decision on Appeal

In the Decision on Appeal dated December 3, 2009, the Board reversed the 35 U.S.C. § 102 rejection of claims 29, 30, 33, 34, 36-40, 42, 44, 46, 48-52, and 54-60, and the § 103 rejection of claims 41 and 53. The Board affirmed the § 101 rejection of claims 29, 30, 34, 36-42, and 55-60, and the § 103 rejection of claims 32 and 45.

The Board also raised a new ground of rejection under § 101 against claims 32 and 33.

In response to the new ground of rejection raised by the Board, Applicant requests reopening of prosecution pursuant to 37 C.F.R. § 41.50(b)(1), based on the submission of this Amendment.

Claim 32 has been cancelled to render the rejections of the claim moot.

Claim 33 (which was the subject of the new ground of rejection raised by the Board) depends from independent claim 42. To address the § 101 rejection raised against claim 33, base claim 42 has been amended to recite “by the computer” in the body of claim 42.

In the Decision on Appeal, the Board pointed to the fact that “executed by a computer” was recited in the preamble, and as such, was insufficient to satisfy the machine test of *In re Bilski*. Without agreeing to the Board’s rationale, Applicant has added “by the computer” into the body of claim 42 to render the § 101 rejection moot. Each of the steps of claim 42 is tied to a particular machine, namely the “computer” recited in claim 42. It is respectfully submitted that claim 42 as amended clearly satisfies the machine test of *In re Bilski*. As held by *In re Bilski*, a “claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus or (2) it transforms a particular article into a different state or thing.” *In re Bilski*, 545 F.3d 943, 954, 956 (Fed. Cir. 2008) (*en banc*) cert. granted, 2009 U.S. LEXIS 4103 (2009).

Also, it is believed that agreement was reached that the amendment of claim 42 (and its dependent claim 33) as made herein as overcome the § 101 rejection.

In view of the foregoing, it is respectfully submitted that the § 101 rejection raised by the Board against claim 33 has been addressed.

Moreover, in view of the amendment of base claim 42, the § 101 rejection of claim 42 has also been overcome.

Similar amendments have been made to independent method claims 38 and 58 to overcome the § 101 rejection of those claims.

In view of the fact that all § 101 rejections have been overcome, the claims are all in condition for allowance in view of the reversal of the § 102 and § 103 rejections made in the Decision on Appeal.

Allowance of all claims is respectfully requested.

The Commissioner is authorized to charge any additional fees and/or credit any overpayment to Deposit Account No. 08-2025 (10007972-1).

Respectfully submitted,

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_____/Dan C. Hu/
Dan C. Hu
Registration No. 40,025
TROP, PRUNER & HU, P.C.
1616 South Voss Road, Suite 750
Houston, TX 77057-2631
Telephone: (713) 468-8880
Facsimile: (713) 468-8883